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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,083	10/31/2003	Wesley Scott Ashton	ASHTON0009	9725
<div>7590 Wesley Scott Ashton 8549 Black Foot Court Lorton, VA 22079</div>			<div>EXAMINER RODRIGUEZ, RUTH C</div>	
			<div>ART UNIT 3677</div>	<div>PAPER NUMBER</div>
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/697,083	<b>Applicant(s)</b> ASHTON, WESLEY SCOTT	
	<b>Examiner</b> Ruth C. Rodriguez	<b>Art Unit</b> 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-27, 31 and 36-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-27, 31, 36-39 and 42-47 is/are rejected.
- 7) ☐ Claim(s) 40 and 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 44 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 44 is very similar to claim 21 and the difference between these two set of claims is that claim 21 recites that "mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip; and dispensing the substance into the wearer's mouth, wherein the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva" while claim 44 recites "mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip so that the first end member and the second end member hold the stud in the fistula; and dispensing the substance into the wearer's mouth, wherein the substance is dispensed by leaching the substance from the stud into the wearer's mouth over time in the wearer's saliva". The term "leaching" is considered new

issue since the specification do not provide any support for this term. For purpose of examination claim 44 will not be examined since it contains new matter.

3. Claims 45 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 45 is very similar to claim 31 and the difference between these two set of claims is that claim 31 recites that "mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip; and dispensing the substance into the wearer's mouth, wherein the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva" while claim 45 recites "mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip so that the first end member and the second end member hold the stud in the fistula; and dispensing the substance into the wearer's mouth, wherein the substance is dispensed by leaching the substance from the stud into the wearer's mouth over time in the wearer's saliva". The term "leaching" is considered new issue since the specification do not provide any support for this term. For purpose of examination claim 45 will not be examined since it contains new matter.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-27, 36, 38, 44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr. (US 6,026,659) in view of Abramowitz (US 3,500,829) and Lefkowitz (US 4,676,752).

Kaping discloses a method to mounting a mouth and tongue stud (10). The method comprises the steps of: (a) providing a mouth and tongue stud (10). The stud comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (C. 3, L. 39-42); (b) mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip (C. 2, L. 5-31). Kaping fails to disclose that the method further comprises dispensing a substance into a mouth, wherein the substance is selected from the group consisting of a breath freshener and a flavoring agent, the mouth and tongue stud also includes a means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substance contains the substance and dispensing the substance into the wearer's mouth, wherein the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva. However, Abramowitz teaches

a method for dispensing a substance (48) into an earlobe. The method comprising the steps of: (a) providing an ear stud including a means (14,16,44) for dispensing a substance (48) formed in a portion of the stud. The means for dispensing a substance contains the substance (Figs. 9 and 10). The stud further comprises a bar (14) having ends, a first end member (44) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (Figs. 9 and 10); (b) mounting the bar of the stud in an aperture formed in a wearer's earlobe (Fig. 10); and (c) dispensing the substance into the earlobe ( Fig. 10). Abramowitz teaches that the stud serves to conveniently and effectively deliver medication or perfume to an aperture in an earlobe allowing healing of the ear and clearing up of infections (C. 1, L. 37-48). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a method for dispensing a substance where the stud includes a means for dispensing a substance formed in a portion of the stud where the means for dispensing the substance contains the substance and the substance being dispensed as taught by Abramowitz in the method disclosed by Kaping with the stud is being used in the mouth and therefore the substance will be dispensed into the wearer's mouth since the fistula formed in the mouth or tongue allows healing of the mouth and clearing up of any infection at the fistula. Doing so, serves to deliver medication conveniently and effectively to a fistula in the wearer's mouth and tongue since both devices deal with piercing on the body. Additionally, Abramowitz teaches that the stud provides a known technique of dispensing a substance in order to combat infections during the healing period following a piercing

operation and therefore it would have been obvious to one having ordinary skill in the art that the stud applying medication to the interior of the fistula in the wearer's mouth and tongue where the medication is selected from a medication for use in the user's mouth just like the stud serves to deliver medication to an aperture in the earlobe during the healing period following a piercing operation. Kaping and Abramowitz fail to disclose that the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva since once the substance is ejected from the reservoir (16) a portion of the substance will be left inside the bar and the substance will then be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva. Additionally, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention that the substance is dispensed as it travels out of the piercing and it will be dissolved over time in the wearer's saliva after being injected into the piercing since time is needed to completely dissolve the substance since substances do not dissolve instantly upon its application to the mouth or tongue. Abramowitz teaches that the stud can be used to deliver perfume but fails to teach that the stud dispenses a breath freshener or flavoring agent. Regarding to the substance being selected from the group consisting of a breath freshener and a flavoring agent, Lefkowitz teaches a device (10) being placed in wearer's mouth to dispense a flavoring agent and/or breath freshener (32) (L. 3-6 of the abstract). Lefkowitz teaches that the use of medications in combination with other fluids and/or

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flavoring (C. 3, L. 1-3) is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to dispense medication, fluids and/or flavoring as taught by Lefkowitz in the device taught by Kaping and modified in accordance with the teachings of Edwards so that the substance being selected from the group consisting of a breath freshener and a flavoring agent. Doing so, allows dispensing of a medication in combination with a breath freshener and/or flavoring agent. Especially since breath freshener and flavoring agents are used to provide pleasant fragrances for the user's mouth just like the perfume taught by Abramowitz provides a pleasant fragrance to the use of the earring.

Lefkowitz also teaches that:

- The substance comprises a breath freshener (C. 3, L. 1-3).
- The substance comprises a flavoring agent (C. 3, L. 1-3).
- The substance includes a breath freshener mixed with the flavoring agent (C. 3, L. 1-3).
- A medication is mixed with the breath freshener (C. 3, L. 1-3).
- A medication is mixed with the flavoring agent (C. 3, L. 1-3).
- A medication is mixed with the breath freshener and the flavoring agent (C. 3, L. 1-3).

Regarding claim 36, the same rejection of claim 21 serves to reject claim 36 since the claim limitations are almost the same and Kaping disclose that the bar is a straight bar made of metal (C. 4, L. 48-67) and the material identification in the drawings of



Abramowitz indicate that the bar is made of metal and the drawings show that the bar is a straight bar.

For claim 38, the same rejection of claim 21 serves to reject claim 38 since the claim limitations are almost the same and Kaping disclose that the first end member and the second end member hold the stud in the fistula (C. 3, L. 43-55). Additionally, Kaping and Abramowitz fail to disclose that the substance is dispensed into the wearer's mouth by diffusing the substance over time in the wearer's saliva, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by diffusing the substance over time in the wearer's saliva since once the substance is ejected from the reservoir (16) a portion of the substance will be left inside the bar and the substance will then be dispensed into the wearer's mouth by diffusing the substance over time in the wearer's saliva. Additionally, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention that the substance is dispensed as it travels out of the piercing and it will be diffused over time in the wearer's saliva after being injected into the piercing since time is needed to completely diffuse the substance since substances do not diffuse instantly upon its application to the mouth or tongue.

Regarding claim 44, the same rejection of claim 21 serves to reject claim 44 since the claim limitations are almost the same and Kaping disclose that the first end member and the second end member hold the stud in the fistula (C. 3, L. 43-55). Additionally, Kaping and Abramowitz fail to disclose that the substance is dispensed into the wearer's mouth by leaching the substance over time in the wearer's saliva, however, it would have

been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by leaching the substance over time in the wearer's saliva since once the substance is ejected from the reservoir (16) a portion of the substance will be left inside the bar and the substance will then be dispensed into the wearer's mouth by leaching the substance over time in the wearer's saliva due to the presence of the openings (38) at the bar (30) that allow saliva to enter the bar and the saliva and substance will leach out of the openings.

The bar is a solid bar and the means for dispensing the substance is formed in the second end member (opening at the end of member 16).

6. Claims 31, 37, 39, 45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr. (US 6,026,659) in view of Abramowitz (US 3,500,829).

Kaping discloses a method to mounting a mouth and tongue stud (10). The method comprises the steps of: (a) providing a mouth and tongue stud (10). The stud comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (C. 3, L. 39-42); (b) mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip (C. 2, L. 5-31). Kaping fails to disclose that the method further comprises dispensing a substance into a mouth, wherein the substance is selected from the group consisting of a breath freshener and a flavoring agent, the mouth and tongue stud also includes a means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substance contains the substance and dispensing the substance into the

wearer's mouth, wherein the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva. However, Abramowitz teaches a method for dispensing a substance (48) into an earlobe. The method comprising the steps of: (a) providing an ear stud including a means (14,16,44) for dispensing a substance (48) formed in a portion of the stud. The means for dispensing a substance contains the substance (Figs. 9 and 10). The stud further comprises a bar (14) having ends, a first end member (44) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (Figs. 9 and 10); (b) mounting the bar of the stud in an aperture formed in a wearer's earlobe (Fig. 10); and (c) dispensing the substance into the earlobe ( Fig. 10). Abramowitz teaches that the stud serves to conveniently and effectively deliver medication or perfume to an aperture in an earlobe allowing healing of the ear and clearing up of infections (C. 1, L. 37-48). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a method for dispensing a substance where the stud includes a means for dispensing a substance formed in a portion of the stud where the means for dispensing the substance contains the substance and the substance being dispensed as taught by Abramowitz in the method disclosed by Kaping with the stud is being used in the mouth and therefore the substance will be dispensed into the wearer's mouth since the fistula formed in the mouth or tongue allows healing of the mouth and clearing up of any infection at the fistula. Doing so, serves to deliver medication conveniently and effectively to a fistula in the wearer's mouth and tongue since both devices deal with

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piercing on the body. Additionally, Abramowitz teaches that the stud provides a known technique of dispensing a substance in order to combat infections during the healing period following a piercing operation and therefore it would have been obvious to one having ordinary skill in the art that the stud applying medication to the interior of the fistula in the wearer's mouth and tongue where the medication is selected from a medication for use in the user's mouth just like the stud serves to deliver medication to an aperture in the earlobe during the healing period following a piercing operation.

Kaping and Abramowitz fail to disclose that the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva since once the substance is ejected from the reservoir (16) a portion of the substance will be left inside the bar and the substance will then be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva. Additionally, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention that the substance is dispensed as it travels out of the piercing and it will be dissolved over time in the wearer's saliva after being injected into the piercing since time is needed to completely dissolve the substance since substances do not dissolve instantly upon its application to the mouth or tongue.

Regarding claim 37, the same rejection of claim 31 serves to reject claim 37 since the claim limitations are almost the same and Kaping disclose that the bar is a straight bar made of metal (C. 4, L. 48-67) and the material identification in the drawings of

Abramowitz indicate that the bar is made of metal and the drawings show that the bar is a straight bar.

For claim 39, the same rejection of claim 31 serves to reject claim 39 since the claim limitations are almost the same and Kaping disclose that the first end member and the second end member hold the stud in the fistula (C. 3, L. 43-55). Additionally, Kaping and Abramowitz fail to disclose that the substance is dispensed into the wearer's mouth by diffusing the substance over time in the wearer's saliva, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by diffusing the substance over time in the wearer's saliva since once the substance is ejected from the reservoir (16) a portion of the substance will be left inside the bar and the substance will then be dispensed into the wearer's mouth by diffusing the substance over time in the wearer's saliva. Additionally, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention that the substance is dispensed as it travels out of the piercing and it will be diffused over time in the wearer's saliva after being injected into the piercing since time is needed to completely diffuse the substance since substances do not diffuse instantly upon its application to the mouth or tongue

Regarding claim 45, the same rejection of claim 31 serves to reject claim 45 since the claim limitations are almost the same and Kaping disclose that the first end member and the second end member hold the stud in the fistula (C. 3, L. 43-55). Additionally, Kaping and Abramowitz fail to disclose that the substance is dispensed into the wearer's mouth by leaching the substance over time in the wearer's saliva, however, it would have

been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by leaching the substance over time in the wearer's saliva since once the substance is ejected from the reservoir (16) a portion of the substance will be left inside the bar and the substance will then be dispensed into the wearer's mouth by leaching the substance over time in the wearer's saliva due to the presence of the openings (38) at the bar (30) that allow saliva to enter the bar and the saliva and substance will leach out of the openings.

The bar is a solid bar and the means for dispensing the substance is formed in opening provided in member 16).

7. Claims 21-27, 36, 38, 42, 44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr. (US 6,026,659) in view of Edwards (US 4,943,274) and Lefkowitz (US 4,676,752).

Kaping discloses a method to mounting a mouth and tongue stud (10). The method comprises the steps of: (a) providing a mouth and tongue stud (10). The stud comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (C. 3, L. 39-42); (b) mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip (C. 2, L. 5-31). Kaping fails to disclose that the method further comprises dispensing a substance into a mouth, wherein the substance is selected from the group consisting of a breath freshener and a flavoring agent, the mouth and tongue stud also includes a means for dispensing a substance formed in a portion of the stud, wherein the means for

dispensing a substance contains the substance and dispensing the substance into the wearer's mouth, wherein the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva. However, Edwards teaches a method for dispensing a substance (22) into an earlobe. The method comprising the steps of: (a) providing an ear stud including a means (16,30,38) for dispensing a substance (22) formed in a portion of the stud. The means for dispensing a substance contains the substance (Figs. 1-4). The stud further comprises a bar (30) having ends, a first end member (50) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (Figs. 1-4); (b) mounting the bar of the stud in an aperture formed in a wearer's earlobe (Fig. 2); and (c) dispensing the substance into the earlobe (C. 3, L. 3-10). Edwards teaches that the stud serves to conveniently and effectively deliver medication to an aperture in an earlobe during the healing period following a piercing operation (C. 1, L. 32-35) and the stud serves to apply medication to the interior of the aperture in the earlobe (C. 3, L. 9-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a method for dispensing a substance where the stud includes a means for dispensing a substance formed in a portion of the stud where the means for dispensing the substance contains the substance and the substance being dispensed as taught by Edwards in the method disclosed by Kaping with the stud is being used in the mouth and therefore the substance will be dispensed into the wearer's mouth since the fistula formed in the mouth or tongue is also prone to infections during the healing period following a piercing operation. Doing

so, serves to deliver medication conveniently and effectively to a fistula in the wearer's mouth and tongue since both devices deal with piercing on the body. Additionally, Edwards teaches that the stud provides a known technique of dispensing a substance in order to combat infections during the healing period following a piercing operation and therefore it would have been obvious to one having ordinary skill in the art that the stud applying medication to the interior of the fistula in the wearer's mouth and tongue where the medication is selected from a medication for use in the user's mouth just like the stud serves to deliver medication to an aperture in the earlobe during the healing period following a piercing operation. Kaping and Edwards fail to disclose that the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva since once the substance is ejected from the reservoir (16) a portion of the substance will be left inside the bar and the substance will then be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva. Additionally, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention that the substance is dispensed as it travels out of the piercing and it will be dissolved over time in the wearer's saliva after being injected into the piercing since time is needed to completely dissolve the substance since substances do not dissolve instantly upon its application to the mouth or tongue. Regarding to the substance being selected from the group consisting of a breath freshener and a flavoring agent, Lefkowitz teaches a device (10) being placed in wearer's



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mouth to dispense a medication and/or breath freshener (32) (L. 3-6 of the abstract).

Lefkowitz teaches that the use of medications in combination with other fluids and/or flavoring (C. 3, L. 1-3) is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to dispense medication, fluids and/or flavoring as taught by Lefkowitz in the device taught by Kaping and modified in accordance with the teachings of Edwards so that the substance being selected from the group consisting of a breath freshener and a flavoring agent. Doing so, allows dispensing of a medication in combination with a breath freshener and/or flavoring agent.

Lefkowitz also teaches that:

- The substance comprises a breath freshener (C. 3, L. 1-3).
- The substance comprises a flavoring agent (C. 3, L. 1-3).
- The substance includes a breath freshener mixed with the flavoring agent (C. 3, L. 1-3).
- A medication is mixed with the breath freshener (C. 3, L. 1-3).
- A medication is mixed with the flavoring agent (C. 3, L. 1-3).
- A medication is mixed with the breath freshener and the flavoring agent (C. 3, L. 1-3).

Regarding claim 36, the same rejection of claim 21 serves to reject claim 36 since the claim limitations are almost the same and Kaping disclose that the bar is a straight bar made of metal (C. 4, L. 48-67) and the material identification in the drawings of

Edwards indicate that the bar is made of metal and the drawings show that the bar is a straight bar.

For claim 38, the same rejection of claim 21 serves to reject claim 38 since the claim limitations are almost the same and Kaping disclose that the first end member and the second end member hold the stud in the fistula (C. 3, L. 43-55). Additionally, Kaping and Edwards fail to disclose that the substance is dispensed into the wearer's mouth by diffusing the substance over time in the wearer's saliva, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by diffusing the substance over time in the wearer's saliva since once the substance is ejected from the reservoir (16) a portion of the substance will be left inside the bar and the substance will then be dispensed into the wearer's mouth by diffusing the substance over time in the wearer's saliva. Additionally, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention that the substance is dispensed as it travels out of the piercing and it will be diffused over time in the wearer's saliva after being injected into the piercing since time is needed to completely diffuse the substance since substances do not diffuse instantly upon its application to the mouth or tongue.

Edwards teaches that the substance has a form selected from the group consisting of a solid crystallized form, a gel (C. 2, L. 21-26), a foam or a table form. Especially since the use of antibiotic gels for oral application is well known in the art of dispensing medication into the wearer's mouth.

Regarding claim 44, the same rejection of claim 21 serves to reject claim 44 since the claim limitations are almost the same and Kaping disclose that the first end member and the second end member hold the stud in the fistula (C. 3, L. 43-55). Additionally, Kaping and Edwards fail to disclose that the substance is dispensed into the wearer's mouth by leaching the substance over time in the wearer's saliva, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by leaching the substance over time in the wearer's saliva since once the substance is ejected from the reservoir (16) a portion of the substance will be left inside the bar and the substance will then be dispensed into the wearer's mouth by leaching the substance over time in the wearer's saliva due to the presence of the openings (38) at the bar (30) that allow saliva to enter the bar and the saliva and substance will leach out of the openings.

The bar is a solid bar and the means for dispensing the substance is formed in the second end member (16 is part of the means for dispensing the substance as shown in Figs. 1-4).

8. Claims 31, 37, 39, 43, 45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr. (US 6,026,659) in view of Edwards (US 4,943,274).

Kaping discloses a method to mounting a mouth and tongue stud (10). The method comprises the steps of: (a) providing a mouth and tongue stud (10). The stud comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (C. 3, L. 39-42); (b) mounting the

bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip (C. 2, L. 5-31). Kaping fails to disclose that the method further comprises dispensing a substance into a mouth, wherein the substance is medicine, the mouth and tongue stud also includes a means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substance contains the substance and dispensing the substance into the wearer's mouth, wherein the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva. However, Edwards teaches a method for dispensing a substance (22) into an earlobe. The method comprising the steps of: (a) providing an ear stud including a means (16,30,38) for dispensing a substance (22) formed in a portion of the stud. The means for dispensing a substance contains the substance (Figs. 1-4). The stud further comprises a bar (30) having ends, a first end member (50) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (Figs. 1-4); (b) mounting the bar of the stud in an aperture formed in a wearer's earlobe (Fig. 2); and (c) dispensing the substance into the earlobe (C. 3, L. 3-10). Edwards teaches that the stud serves to conveniently and effectively deliver medication to an aperture in an earlobe during the healing period following a piercing operation (C. 1, L. 32-35) and the stud serves to apply medication to the interior of the aperture in the earlobe (C. 3, L. 9-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a method for dispensing a substance where the stud includes a means for dispensing a substance formed in a portion of the stud where the

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means for dispensing the substance contains the substance and the substance being dispensed as taught by Edwards in the method disclosed by Kaping with the stud is being used in the mouth and therefore the substance will be dispensed into the wearer's mouth since the fistula formed in the mouth or tongue is also prone to infections during the healing period following a piercing operation. Doing so, serves to deliver medication conveniently and effectively to a fistula in the wearer's mouth and tongue since both devices deal with piercing on the body. Additionally, Edwards teaches that the stud provides a known technique of dispensing a substance in order to combat infections during the healing period following a piercing operation and therefore it would have been obvious to one having ordinary skill in the art that the stud applying medication to the interior of the fistula in the wearer's mouth and tongue where the medication is selected from a medication for use in the user's mouth just like the stud serves to deliver medication to an aperture in the earlobe during the healing period following a piercing operation. Kaping and Edwards fail to disclose that the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva since once the substance is ejected from the reservoir (16) a portion of the substance will be left inside the bar and the substance will then be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva. Additionally, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention that the substance

is dispensed as it travels out of the piercing and it will be dissolved over time in the wearer's saliva after being injected into the piercing since time is needed to completely dissolve the substance since substances do not dissolve instantly upon its application to the mouth or tongue.

Regarding claim 37, the same rejection of claim 31 serves to reject claim 37 since the claim limitations are almost the same and Kaping disclose that the bar is a straight bar made of metal (C. 4, L. 48-67) and the material identification in the drawings of Edwards indicate that the bar is made of metal and the drawings show that the bar is a straight bar.

For claim 39, the same rejection of claim 31 serves to reject claim 39 since the claim limitations are almost the same and Kaping disclose that the first end member and the second end member hold the stud in the fistula (C. 3, L. 43-55). Additionally, Kaping and Edwards fail to disclose that the substance is dispensed into the wearer's mouth by diffusing the substance over time in the wearer's saliva, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by diffusing the substance over time in the wearer's saliva since once the substance is ejected from the reservoir (16) a portion of the substance will be left inside the bar and the substance will then be dispensed into the wearer's mouth by diffusing the substance over time in the wearer's saliva. Additionally, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention that the substance is dispensed as it travels out of the piercing and it will be diffused over time in the wearer's saliva after being injected into the

piercing since time is needed to completely diffuse the substance since substances do not diffuse instantly upon its application to the mouth or tongue

Edwards teaches that the substance has a form selected from the group consisting of a solid crystallized form, a gel (C. 2, L. 21-26), a foam or a table form. Especially since the use of antibiotic gels for oral application is well known in the art of dispensing medication into the wearer's mouth.

Regarding claim 45, the same rejection of claim 31 serves to reject claim 45 since the claim limitations are almost the same and Kaping disclose that the first end member and the second end member hold the stud in the fistula (C. 3, L. 43-55). Additionally, Kaping and Edwards fail to disclose that the substance is dispensed into the wearer's mouth by leaching the substance over time in the wearer's saliva, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by leaching the substance over time in the wearer's saliva since once the substance is ejected from the reservoir (16) a portion of the substance will be left inside the bar and the substance will then be dispensed into the wearer's mouth by leaching the substance over time in the wearer's saliva due to the presence of the openings (38) at the bar (30) that allow saliva to enter the bar and the saliva and substance will leach out of the openings.

The bar is a solid bar and the means for dispensing the substance is formed in the second end member (16 is part of the means for dispensing the substance as shown in Figs. 1-4).

***Allowable Subject Matter***

9. Claims 40 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

10. Applicant's arguments with respect to claims 21-27, 31, 36-39 and 41-47 have been considered but are moot in view of the new ground(s) of rejection.

11. The Applicant argues that the definition of syringe is "a device used to inject fluids into the body or to draw them from it" since Edwards discloses that its device is a syringe. The Examiner fails to be persuaded by this argument. The claims fail to include limitations that exclude the use of syringes as part of the means for dispensing a substance. The new rejection of the claims addresses this limitation and explains how this limitation is being met.

12. An argument is that the device of Edwards will not allow the substance to be "dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva." This argument fails to persuade. The substance can be ejected from the stud when the end member (16) is squeezed. However as explained in the office action, this substance will not dissolve instantly and some time is required for it to be



dissolved. Additionally, a portion of the substance remain within the stud and the portion remaining within the stud will dissolve over time in the wearer's saliva.

13. The Applicant argues that the device of Edwards can not be used on the mouth or tongue since disclosure recites that the device is used for an earlobe piercing and not a piercing in the body. This argument fails to persuade. The tongue or mouth are still a part of the body and a piercing provided in any of these two location will still be considered as a piercing on the body. A piercing on the tongue or mouth is a piercing on the body because the pierced member is part of the body regardless of whether the piercing is exposed to the environment or located within the mouth. Additionally, Denny does not require that the piercing needs to be in the skin.

14. The Applicant makes reference to a publication of Barton Schmidt to indicate that medication meant for external could not be used to treat a piercing in the mouth or tongue. The Examiner acknowledges that medication used for external use can not be used for a piercing in the tongue or mouth, however Lefkowitz clearly teaches that there are medication used to fight infection located in the user's mouth and these medication are clearly meant for internal use. A person of ordinary skill in the art will acknowledge that the medication being used to treat a piercing will depend on the location of the piercing and there a wide variety of medications used to fight infection in the mouth that can be used in combination with the device of Kaping and modified by Edwards to treat a piercing in the tongue or mouth.

15. The Applicant argues that the pointed protruded end 54 of the device of Edwards can cause injury to an user. This argument fails to persuade because the Examiner is

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not replacing both ends of the stud of Kaping with the ends of the stud of Edwards.

Only the end having member 16 is being replaced. As a result, no pointed protruded end will be provided from the combination.

16. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the use of a neoprene, polypropylene or polyethylene housing that is squeezable in the mouth being used to enhance sexual activity) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, the housing may be easily compressed, however, that does not prevent its use as a reservoir not does it prevent its use as a retaining member for the stud.

17. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both devices pertain to dispensing medication to a pierced member and therefore can be combined.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kaping, Jr. (US 6,244,073) is cited to show state of the art with respect to tongue or mouth stud that are mounted in a fistula in the user's tongue or mouth.

Cáslavk/ et al. (US 4,454,110) is cited to show state of the art with respect to the use of antibiotic gels for topical application in the oral cavity.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor D. Batson can be reached on (571) 272-6987.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

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/RCR/  
Ruth C. Rodriguez  
Patent Examiner  
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rcr  
March 24, 2008

/Robert J. Sandy/  
Acting SPE of Art Unit 3677